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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,520	04/14/2004	Jerald C. Seelig	619.897	6587
21707	7590	08/06/2007		
IAN F. BURNS & ASSOCIATES P.O. BOX 71115 RENO, NV 89570			EXAMINER MOSSER, ROBERT E	
			ART UNIT	PAPER NUMBER
			3714	
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			08/06/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/824,520

Applicant(s)

SEELIG ET AL.

Examiner

Robert Mosser

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

The declaration filed on May 31<sup>st</sup>, 2007 under 37 CFR 1.131 has been considered but is ineffective to overcome the Baerlocher et al (US 6,315,664) reference.

The Baerlocher et al (US 6,315,664) reference is a U.S. patent or U.S. patent application publication of a pending or patented application that claims the rejected invention. An affidavit or declaration is inappropriate under 37 CFR 1.131(a) when the reference is claiming the same patentable invention, see MPEP § 2306. If the reference and this application are not commonly owned, the reference can only be overcome by establishing priority of invention through interference proceedings. See MPEP Chapter 2300 for information on initiating interference proceedings. If the reference and this application are commonly owned, the reference may be disqualified as prior art by an affidavit or declaration under 37 CFR 1.130. See MPEP § 715.05 & 718.

At least pending claims **1**, **12**, and **29** considered in combination, include limitations generally directed to the following elements:

- (1) a randomly generated bonus qualify event.
- (2) a value acceptor
- (3) an input device
- (4) a controller for enabling the operation of the game device
- (5) a bonus game outcome based on a binary game with two possible outcomes
- (6) allowing a player to place a wager to play a game
- (7) displaying the binary outcome to the player

Art Unit: 3714

(8) awarding a prize to the player.

These features correlated to the Patented claims of US 6,315,664 in the following manner

Item (1) is provide for as a Element (a) of patented claim 29 as a trigger event and would have been considered obvious to incorporate into a wagering device as set forth by patented claim 21 so as to allow the acceptance of a wager at the time of invention.

Items (2) and (6) are considered implicit to a gaming device and/or obvious to incorporate into a wagering device as set forth by patented claim 21 so as to allow the acceptance of a wager.

Item (3) is provided for through the selector of patented claim number 21.

Item (4) is provided for as a processor of patented claim 21.

Item (5) is considered taught through the binary game outcome of a success or failure indicator outcomes as presented in at least patented claim 21.

Item (7) is provided for through the display device and utilization thereof set forth in at least patented claim number 21.

Item (8) is provided for through the providing of an award to the player of patented claim number 21.

As provided in 37 CFR 41.203(a), an interference exists if the subject matter of a claim

Art Unit: 3714

of one party would, if prior art, have anticipated or rendered obvious the subject matter of a claim of the opposing party and vice versa. An applicant who is claiming an invention which is identical to, or obvious in view of, the invention as claimed in a domestic patent or patent application publication cannot employ an affidavit under 37 CFR 1.131 as a means for avoiding an interference with the reference. To allow an applicant to do so would result in the issuance of two patents to the same invention.

Additionally, (though not required due to the utilization of declaration under 1.131 being ineffective to antedate the same claimed invention) the following analysis is provided as a service to the Applicant. The presented evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Baerlocher et al (US 6,315,664) reference.

The 1.131 declaration proposes an *actual reduction to practice* of the invention prior to the filing date of the prior art however this proposition would seem to be contradicted by the evidence submitted with the 1.131 declaration. Specifically the second full paragraph of the 5/26/2000 memo addressed to Mac Seelig describes the development of a concept for a S+ type slot machine but does not suggest that this developed concept has materialized into a physical embodiment of the claimed invention. This question of whether or not the claimed invention had been actually reduced to practice at the time proposed by Applicant is further supported by the fifth full paragraph of the memo which states that a prototype of the invention will not be

Art Unit: 3714

available until the end of August. The drawing evidence submitted with the document created May 22<sup>nd</sup>, 2000, additionally fails to demonstrate that the claimed invention had been reduced to practice by the proposed date. An actual reduction to practice in the case of a design for a three-dimensional article requires that it should be embodied in some structure other than a mere drawing.); Kendall v. Searles, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949),

In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose.(MPEP 515.07). In some cases this reduction may be exhibited through the mere construction of the device however the present declaration does not contain proof of the actual device prior to the date of filing for the Baerlocher et al reference.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims **1-6, 8, 10-17, 28-30, 34, and 36** are rejected under 35 U.S.C. 102(e) as being anticipated by Baerlocher et al (US 6,315,664).

Claims **1-3, 12, 15, 16, and 34**: Baerlocher teaches a gaming system including a base game that randomly generates a bonus-qualifying event (See Col 2:34-42), and a bonus game. The bonus game including a game outcome founded on a plurality of binary results conveyed through two different indicia (See Col 2:43-64, & Figures 3 and 4) and awarding a prize to the player based on a number of winning outcomes (See Col 7:54-59).

Claim **4**: Baerlocher teaches entitling the player to a predefined payout based on a number of binary outcomes being displayed (See Col 6:44-51).

Claims **5-6, and 13**: Baerlocher teaches the inclusion of a display object containing two different indicia (See Figures 4, 5, & Col 3:15-22).

Claims **8, 14, and 30**: Baerlocher teaches that each display object is capable of displaying at least two different indicia (See Figure 4, & Col 5:59-6:10)

Claims **10-11, 17, 28, and 36**: Baerlocher teaches the use of a touch screen video display in communication with a controller to allow the player to select success indicators as defining a winning outcome (See Col 4:66-5:5).

Claim **24**: Baerlocher teaches disregarding a failure outcome result determination for a success determination if a relatively high number for failure determination have been made to avoid player frustration (See Col 7:3-10).

Art Unit: 3714

**Claim 29:** Baerlocher teaches the inclusion of value acceptors (See Col 4:11-18), player input devices (See Col 4:19-22), and a controller for determining the randomly decided game outcomes (See Elm 36, & Col 5:61-6:10).

Claims **12-23, 25-27, and 29-35** are rejected under 35 U.S.C. 102(b) as being anticipated by Gutknecht (US 5,154,420).

Claims **12, and 29:** Gutknecht teaches allowing a player to place a wager and play a game of chance (See Col 1:59-2:5), determining a plurality of binary game outcomes (See Figure 1, Elm 54, 58), a coin/value acceptor to accept wagers (See Elm 44), a plurality of player input devices (See Col 2:53-65), a controller for randomly determining a game outcome (See Col 5:7-24), a display for displaying the plurality of binary game outcomes to the player, and awarding the player a payout based on a winning outcome (See Figure 1 & Col 1:59-2:5).

Claims **13-18, 26-27, and 30-35:** Gutknecht teaches displaying of the two possible game outcomes to the player for each game object during the determination of the game outcome through the rotation of the game objects and allowing the player to select which indicator on each object will serve as the winning indicator (See Col 1:61-2:5).

Claims **19-23, and 25:** Gutknecht teaches use of a "triple or nothing" game feature for allowing a player wager a first prize for a large secondary prize comprising a multiple of the first prize and dependent on multiple binary game outcomes (See Figure 1, & Col 2:66-3:2).



***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 7, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baerlocher et al (US 6,315,664).

Baerlocher is silent regarding each display object representing a coin, however Baerlocher teaches that the particular appearance of the display object utilized for enacting the bonus game as taught above as being immaterial to Baerlocher's invention (Col 5:54-58) and as such, the display objects of Baerlocher could be widely varied sizes, shapes and colors.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to utilize a display objects resembling coins in the game of Baerlocher because, one of ordinary skill in the art at

the time of invention would have recognized that the embodiment of the display object is immaterial to the to the invention as taught by Baerlocher. One of ordinary skill in the art, furthermore, would have expected the display objects of Baerlocher representing boxes and/or dodge ball players (See Figures 4-5), and the Applicant's claimed display object resembling a coin to perform equally well as both methods would serve to convey the result of a binary game outcomes.

Therefore it would have been prima facie obvious to modify Baerlocher in order to obtain the invention as specified in claim(s) 7 and 27, because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Baerlocher.

#### ***Response to Arguments***

Applicant's arguments filed May 31<sup>st</sup>, 2007 have been fully considered but they are not persuasive. The merits of the 1.131 declaration have been addressed above in the section entitles "Response to Amendments". Though the evidence is presently not capable of supporting an actual reduction of practice, the presented evidence *might in part suggest* conception of the claimed invention prior to the invention of Baerlocher et al. The Applicant's may wish to consider this alternative method of antedating the prior art reference if further support would be unavailable for the establishment of an actual reduction to practice.

Applicant's arguments directed to the Gutknecht reference suggests that the game outcome of Gutknecht is premised on a quaternary game outcome juxtapose to the binary game outcome claimed by the Applicant. With respect to this argument the

Art Unit: 3714

Examiner notes that though the interpretation of the game outcome of Gutknecht may be appropriated described as a quaternary game outcome, it may be equally appropriately described as a combination of two binary game outcomes. The presented claims provide for at least one binary game outcome and therefore would accurately encompass the presentation of two binary game outcomes.

The Declaration submitted under 1.132 has been received and placed in the Application file.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



MARK SAGER  
PRIMARY EXAMINER

July 24<sup>th</sup>, 2007  
/RM/